

REMARKS

Reconsideration of the application is respectfully requested based on the following remarks.

In the Office Action, the Examiner rejected claims 1-8 and 10-36. The Examiner objected to claim 9 for being dependent upon a rejected claim. Claims 1, 4-8, 11-13, 15-30 and 32-33 have been amended herein without intending to abandon or publicly dedicate any patentable subject matter. Claims 2, 3, 9, 10, 14, 31 and 34-36 have been canceled herein without prejudice or disclaimer. Claim 9 has been rewritten in independent form and presented as new claim 37. New claims 38 and 39 have been added. As such, claims 1, 4-8, 11-13, 15-30, 32-33 and 37-39 are currently pending.

REJECTION OF CLAIMS 1-8, 11-13 and 15-36 UNDER 35 USC §102(b)

In the Office Action, the Examiner rejected claims 1-8, 11-13, 15-36 under 35 U.S.C. 102(b) as being anticipated by Arias (5657965). The Examiner stated, "Arias discloses an apparatus having a chambered base member (100), tongue (58), a chambered lever (200) with teeth (112&115) with a means for wedge or grooves (which is the space between the teeth), and a cross bar (300) with a spring." Applicant respectfully disagrees.

Arias discloses a device for removing staples and tacks includes an upper jaw and a lower jaw pivotally connected to one another, the upper jaw including spaced, parallel teeth disposed in opposing relation to spaced, parallel teeth on the lower jaw. A wedge member extends from the upper jaw, between the teeth thereof and terminates at an acute distal edge beyond pointed distal ends of the teeth. A flat outer surface of the wedge member is angled slightly outward relative to the upper teeth so that the distal edge is disposed at an optimum angle of attack to slide under the staple or tack when closing the jaws, and an inner bearing surface of the wedge member is structured and disposed for engaging and initiating prying of the staple or tack from the object as the upper and lower jaws are further closed toward a closed position, thereby enabling the teeth of the jaws to pass under and engage the staple or tack to complete removal thereof from the object (Abstract).

Regarding claim 1 and dependent claims 4-8, 11-13, 15-17 and 21-27, Applicant has amended claim 1 to now recite,

**“a base member having a front end, a rear end, and a first section near said front end, said base member further having a substantially flat surface for resting on the substrate during removal of the staple;
a lever member having a front end, a rear end, and a first section near said front end, said first section of said lever member being pivotally joined to said first section of said base member;
a tongue extending from said first section of said base member and parallel to said flat surface for wedging under a crossbar of the staple and supporting the substrate during removal of the staple; and
means for lifting the staple from the substrate using a leverage from said lever member when said lever member is rotated away from said base member, said lifting means joined to said first section of said lever member where said lifting means remains above said flat surface of said base member during the staple removing operation.”**

Arias does not disclose in the Figs. 1-6 or the descriptions a **base member further having a substantially flat surface for resting on the substrate during removal of the staple**. Arias does not disclose a **tongue extending from said first section of said base member and parallel to said flat surface for wedging under a crossbar of the staple and supporting the substrate during removal of the staple**. Arias does not disclose a **lever member is rotated away from said base member**. Applicant's invention as shown in the figures and claimed in claim 1 is substantially different than what is disclosed by Arias. Applicant believes that Arias does not anticipate Applicant's claimed invention of claim 1. Applicant respectfully requests the Examiner to withdraw the 35 U.S.C. 102(b) rejections of claim 1 and dependent claims 4-8, 11-13, 15-17 and 21-27.

Regarding independent claims 18-20, 28-30 and dependent claims 32 and 33, Applicant has amended these independent claims to now recite, in relevant part,

“a stapler for driving the staple into the substrate, said stapler comprising a stapler base having a front end, a rear end and a substantially flat surface for resting on the

substrate; and a staple driving lever having a front end and a rear end, said staple driving lever pivotally joined to said stapler base, where said rear end of said stapler base and said stapler lever is the staple driving end...”

Applicant claims **a stapler for driving the staple into the substrate** is included in Applicant invention. Arias does not describe or show a stapler as part of a staple remover. Furthermore, Applicant has amended these claims to further include elements of claim 1 that are not anticipated by Arias. Applicant believes that Arias does not anticipate Applicant's claimed invention of these claims. Applicant respectfully requests the Examiner to withdraw the 35 U.S.C. 102(b) rejections of independent claims 18-20, 28-30 and dependent claims 32 and 33.

Regarding claims 2, 3, 31 and 34-36, Applicant has canceled these claims herein without prejudice or disclaimer. As such, the Examiner's rejection of these claims is moot.

REJECTION OF CLAIMS 10 and 14 UNDER 35 USC §103(a)

In the Office Action, the Examiner rejected claims 10 and 14 under 35 U.S.C. 103(a) as being unpatentable over Arias (5657965) in view of Koo (5195724). Applicant has canceled these claims herein without prejudice or disclaimer. As such, the Examiner's rejection of these claims is moot.

ALLOWABLE SUBJECT MATTER

In the Office Action, the Examiner stated, “claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.” Applicant gratefully acknowledges the Examiner's indication of allowable subject matter. Applicant has rewritten claim 9 in independent form including all of the limitations of the base claim and any intervening claims and has presented this claim as new claim 37.

NEW CLAIM 38 AND 39

Applicant has presented new claims 38 and 39. Regarding these claims, Applicant has invoked 35 USC §112(6) by virtue of claim format, which requires that Examiner look into Applicant's specification, and identify each corresponding structure that is supposedly

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anticipated by the cited prior-art. Applicant believes that claim 38 at least encompasses the features of independent claim 1. Applicant believes that claim 39 at least encompasses the features of independent claim 18. Applicant respectfully requests that the Examiner properly examine claims 38 and 39 under 35 USC 112(6) and allow these claims for at least the reasons stated above for claims 1 and 18.

OTHER CITED REFERENCES

The Examiner also cited other references on PTO Form-892, but did not use these references to reject the claims. As implied by the fact that these references were not used to reject the claims, these additional references do not teach or suggest the features of Applicant's claimed invention. Thus, it is submitted that all claims are patentably distinct from these additional references.

CONCLUSION

It is submitted that cited references, alone or in any combination, do not teach or suggest the features of the claimed invention. Therefore, it is submitted that claims 1, 4-8, 11-13, 15-30, 32-33 and 37-39 are patentably distinct from the cited references. Reconsideration of the application and an early Notice of Allowance are earnestly solicited.

If there are any issues remaining which the Examiner believes could be resolved through either a Supplemental Response, an Examiner's Amendment, or otherwise if the Examiner believes that further discussion would expedite the prosecution of this application, the Examiner is respectfully requested to contact the undersigned attorney at the telephone number listed below.

Applicant believes that no extension fees are due in connection with this filing; however, Applicant hereby petition for an extension of time which may be required to maintain the pendency of this case, and for any required fee for such extension or any further fee required in connection with the filing of this Amendment, the Commissioner is hereby requested to notify Applicant of any payment due that is not otherwise paid with this letter.

Respectfully submitted,
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